

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 12-28 are now present in this application. Claims 12, 13, 17, and 20 are independent. Claims 1-11 have been previously canceled without prejudice to being presented in a continuing patent application. Claim 19 is amended to change "pulses" to - - pulse - - to make the language consistent with what is recited in claim 17, from which claim 19 depends. No new matter is involved.

Reconsideration of this application is respectfully requested.

I. Claim Objections

Claims 17-19 are objected to by the Examiner. Applicants respectfully traverse the objection to claims 17-19.

The Office Action indicates that the language "while being varied" is not understood in context with the remainder of claim 17. Applicants respectfully submits that meaning of the language "while being varied" is clear when taken in context with the remainder of claim 17.

Applicants respectfully submit that the language "while being varied" is an adverbial clause that modifies "a value of a factor having influence on recording characteristics is recorded, as test data" and (2) "while being varied"

in lines 6-7 of claim 17 modifies “a value of a second factor having an influence on the recording characteristics is recorded, as test data.”

The Office Action asks if Applicants are attempting to say that the test signals are “variable.” Applicants agree with this statement as long as “test signals” are actually the quoted values in the immediately preceding paragraph.

Furthermore, as noted below, currently pending claim 17 is really original claim 19 re-written in independent form. Applicants believe that the meaning of currently amended claim 17 is as clear as original claim 19 and respectfully note that the first Office Action did not object to original claim 19 for the reason stated in this objection.

Accordingly, Applicants respectfully submit that the meaning of “while being varied” is clear in the context of claims 17-19.

Reconsideration and withdrawal of this objection to claims 17-19 are respectfully requested.

Nevertheless, should the Examiner believe that a telephone interview will be helpful in resolving this issue, the Examiner is invited to contact Applicants' below-named representative at the telephone number set forth below.

Rejection under 35 U.S.C. § 112, First Paragraph

Claims 17-19 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action fails to find support in the specification as originally filed for the feature found in the ultimate paragraph of claim 17.

The last clause of claim 17 states: "wherein the value of another factor includes a format of a recording pulse for a determination of a recording signal format involving an optimum recording condition."

Applicants respectfully submit that support for this clause is found throughout Applicants' originally filed disclosure. In this regard, Applicants note that its original disclosure includes not only the main body of the specification and the drawings, but also the originally filed claims. It is well settled, for example, that the claims as filed are part of the specification, and may provide or contribute to compliance with Section 112. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) (the original claims are part of the patent specification); In re Benno, 768 F.2d 1340, 1346, 226 USPQ 683, 686-87 (Fed. Cir. 1985); In re Frey, 166 F.2d 572, 575, 77 USPQ 116, 119 (CCPA 1948), cited in Hyatt v. Boone, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

Further, in this regard, Applicants respectfully direct the Examiner's attention to originally filed claim 19, which reads, with emphasis added, as follows:

"The re-writable optical recording medium according to claim 17, wherein the second field is a field on which a format of recording pulses is recorded, as test data, while being varied, for a determination of a recording signal format involving an optimum recording condition."

Applicants respectfully submit that originally filed claim 19 provides clear support for the language of the last clause of currently pending claim 17.

As to the meaning of a "value" and the meaning of "another factor," that language is clearly found in originally filed claim 17.

Applicants respectfully submit that the currently pending version of claim 17 recites what was recited in originally filed claim 19 if claim 19 were re-written in independent form. Instead of re-writing claim original claim 19 in independent form, however, Applicants chose to add subject matter from claim 19 into claim 17, which is just another way of accomplishing essentially the same thing.

Applicants also respectfully submit that claim 17, as currently amended, is clearly supported by originally filed claims 17 and 19, which Applicants believe provide clear support for the identification of a "format" of the recording signal and of a "value" of "another factor."

Accordingly, this rejection of claims 17-19 under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn.

The Office Action only focuses on claim 17 and does not mention any support problems with currently pending claims 18 and 19 other than they fall based on the alleged problems with claim 17.

Nevertheless, in order to be completely responsive to the rejection, Applicants note that currently pending claim 18 retains the same wording that it had when originally filed, and that support for the language in currently pending claim 19 for “wherein the format of recording pulses recorded on the second field includes width and/or level of recording pulses.” Support for this language is found, for example, in originally filed claim 10.

Reconsideration and withdrawal of this rejection, under 35 U.S.C. § 112, first paragraph, of claims 17-19 are respectfully requested.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

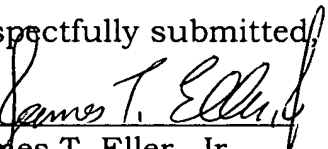
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: FEB 10 2006

JTE/RJW/bsh 

Respectfully submitted,

By 

James T. Eller, Jr.

Registration No.: 39,538

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant